REMARKS

Claims 1, 2 and 8 are all the claims pending in the application.

The Office Action indicates that claims 1-4 and 6-8 are again rejected under 35 U.S.C. § 103(a) as being unpatentable over the combined teachings of Sato et al EP 1 211 242, and Sato et al JP 2001-151749.

Applicants respectfully traverse the rejection for the reasons of record and submit that the Examiner has engaged in improper hindsight reasoning as there is no teaching or suggestion in the cited references to make the compounds of the present invention, whether taken alone or in combination. Additionally, Applicants submit that the claimed compounds provide unexpectedly superior effects in view of their sleep inducing activity.

Contrary to the Examiner's assertion, the skilled person would not randomly combine distinct features of the substituents of the prostaglandin derivatives disclosed in the cited references to arrive at the compounds of the present invention. The Examiner's position is analogous to an "obvious to try" rationale which requires choosing from *a finite number of identified, predictable solutions*, with a reasonable expectation of success. However, prostaglandins are particularly characterized by a wide variety of physiological actions: see, e.g., Sato 242', paragraph [0002]. Thus, to modify partial structures of a specific series of prostaglandins for the purpose of improving a property may result in the total loss of the property and instead the appearance of a different property. Such contemplated modifications often will bring about unpredictable results, where the likelihood of success with the aim at improving the property (such as sleep-inducing activity) is not high. Therefore, it would not have been obvious for one of ordinary skill in the art to try structural modifications with a reasonable

expectation of success in arriving at the claimed compounds with demonstrated sleep-inducing activity based on animal test data provided in the present specification.

As previously pointed out, it is not obvious from Sato '749 that prostaglandin derivatives, wherein a sulfur containing substituent further comprising an ethynylene group is connected to the cyclopentane ring via a $-CH_2-$ group, also have activity as sleep inducing agents.

Sato '242 lacks the ethynylene group in the sulfur containing substituent of the cyclopentane ring and therefore the sleep inducing effects of the present compounds could not have been expected.

Further, neither reference recognizes the unexpectedly superior sleep inducing effects of the present compounds due to this difference in the structure. It could also not be foreseen by the person skilled in the art, that the prostaglandin derivatives as claimed show a sleep inducing effect since the claimed compounds are structurally modified with regard to the prior art compounds and the effect of the structural modification could not have been predicted.

Furthermore, neither Sato '749 nor Sato '242 teaches or suggests modification of the prior art compounds in the direction of the present invention to provide prostaglandin derivatives with a sleep inducing effect. Thus, the present invention is patentable over the cited references, whether taken alone or in combination.

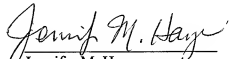
Accordingly, Applicants respectfully request withdrawal of the rejection.

II. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Jennifer M. Hayes
Registration No. 40,641

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

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